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10/532,712	11/16/2005	Masayuki Satake	052519	8960
38834 7590 11/17/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
HUANG, CHENG YUAN				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
11/17/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary

Application No.

10/532,712

Applicant(s)

SATAKE ET AL.

Examiner

CHENG HUANG

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 14-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-9 and 14-15 in the reply filed on 17 August 2009 is acknowledged.
2. Claims 10-13 and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 17 August 2009.

NOTE: Applicant failed to affirm the election without traverse of claims 1-9 and 14-15 (see paragraph 3 of the office action mailed 16 April 2009). While prosecution on the merits is being continued, for completeness of record, the applicant is advised to comply with the above.

Claim Objections

3. Claims 1 and 9 are objected to because of the following informalities:
4. Regarding claim 1, the last word "file" should be corrected to read "film".
5. Regarding claim 9, the first word of the claim "The" should be corrected to read "An" for proper antecedent basis.
6. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 2 recites “a second optical film” which has already been recited in claim 1. The claim is unclear because the claim, depending on claim 1, may contain the at least one layer of a second optical film and the further at least one layer of another second optical film. It is unclear whether the claimed embodiment may have two second optical films or that in the instance claim 1 contains a second optical film, claim 2 contains a second adhesive layer and not a second optical film. For the purpose examination, the at least one layer in claim 2 is considered to be either a second optical or a second adhesive layer regardless of whether claim 1 already contains a second optical film.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1-4, 9, and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287).
12. Regarding claim 1, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) comprising a first optical film provided (protection plate, paragraph [0077]), a first adhesive layer laminated on at least one side of the first optical film

(silicone adhesive 424, paragraph [0081], Figs. 3 and 7), and at least one layer of a second optical film (base plate 421, paragraph [0079]), the at least one layer being provided on a surface on the side opposite to a first surface of a first adhesive layer (horizontal surfaces of silicone adhesive 424, paragraph [0081]) where a first optical film is (Figs. 3 and 7), wherein at least a portion of an edge of the first adhesive layer is an inside edge that is located on the inside of an edge line of the first optical film and the inside of an edge line of the least one layer of a second optical film (Figs 3 and 7).

13. Regarding claim 2, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) which further comprising at least one layer of a second adhesive layer (spacer 425, paragraph [0086]).

14. Regarding claim 3, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) wherein a portion of the inside edge in cross section extends to the vicinity of the edge line of the optical film (Figs 3 and 7).

15. Regarding claims 4 and 14, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) wherein the inside edge has a concave edge (silicone adhesive 424, Fig. 7).

16. Regarding claim 9, Miyazawa teaches an image display device (liquid crystal panels, paragraph [0135]) comprising the adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. Claims 4-8 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287).

20. Miyazawa et al. is relied upon as disclosed above.

21. Regarding claims 4-8 and 14-15, the claimed limitations are regarded as changes in shape and are generally recognized as a design choice and as being within the level of ordinary skill in the art, absent unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04 (IV).

22. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the shape and amount of adhesive in the adhesive optical film of Miyazawa to control the strength or tightness of adhesion and internal sealability (paragraph [0110]).

23. Claims 1-9 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atagi (JP2000214324A) in view of Miyazawa et al. (U.S. Patent Application Publication No. 2002/0191287).
24. Regarding claim 1, Atagi teaches an adhesive optical film (optical film 3, paragraph [0007]) comprising a first optical film (optical film 1, paragraph [0012]), a first adhesive layer (adhesive layer 2, paragraph [0012]) laminated on at least one side of the first optical film (Fig. 1), and at least one layer of a release film (protection film 25, paragraph [0026]) or a second optical film (TAC films 21 or 22, paragraphs [0009] and [0025]).
25. Atagi fails to teach the at least one layer being provided on a surface on the side opposite to a first surface of the first adhesive layer where the first optical film is provided.
26. However, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) comprising at least one layer (base plate 421, paragraph [0079]) being provided on a surface on the side opposite to a first surface of a first adhesive layer (silicone adhesive 424, paragraph [0081]) where a first optical film is provided (protection plate, paragraph [0077], Figs. 3 and 7), wherein at least a portion of an edge of the first adhesive layer is an inside edge that is located on the inside of an edge line of the first optical film and the inside of an edge line of the least one layer of a second optical film (base plate 421, Figs 3 and 7).
27. It would have been obvious to one of ordinary skill in the art at the time of the invention to include the second optical film of Miyazawa on a surface on the side opposite to a first surface of a first adhesive layer where a first optical film is provided in the adhesive optical film of Atagi

to control internal light absorption, boundary reflection, and light transmittance (Miyazawa, paragraph [0079]).

28. Regarding claim 2, Atagi teaches an adhesive optical film (optical film 3, paragraph [0016]) further comprising a second adhesive layer (pressure sensitive adhesive layer 23, paragraph [0025]) (Fig. 6).

29. Regarding claim 3, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein a portion of the inside edge in cross section (edge of adhesive 2, paragraph [0007]) extends to the vicinity of the edge line of the first optical film (edge of phase difference film 24, paragraph [0025]) (Fig. 6).

30. Regarding claims 4, 5, 14, and 15, Atagi fails to disclose an adhesive-type optical film (optical film 3) having the claimed convex and concave shapes of the inside edge of the adhesive.

31. However, regarding claims 4 and 14, Miyazawa teaches an adhesive optical film (polarization plate with adhesive, paragraphs [0101]-[0103]) wherein the inside edge has a concave edge (silicone adhesive 424, Fig. 7).

32. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the shape of adhesive in the adhesive optical film of Miyazawa to control the strength or tightness of adhesion and internal sealability (paragraph [0110]).

33. Furthermore, the claimed limitations are regarded as changes in shape and are generally recognized as a design choice and as being within the level of ordinary skill in the art, absent unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04 (IV).

34. Regarding claim 6, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein the field of the first optical film projected from the adhesive layer's end face may be along the entire perimeter of the first film (paragraphs [0013]-[0016]) which corresponds to the inside edge being formed on at least one-half of the total perimeter of the adhesive layer.
35. Regarding claim 7, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein the inside edge is formed on the whole of the edge line of the first adhesive layer (Fig. 6).
36. Regarding claim 8, Atagi teaches an adhesive optical film (optical film 3, paragraph [0012]) wherein a distance between the inside edge and the edge line of the first optical film is at most about 150 μm (paragraph [0013]) which overlaps the claimed range of 10 to 300 μm .
37. Regarding claim 9, Atagi teaches an image display device (liquid crystal display) comprising the adhesive optical film (optical film 3, paragraph [0012]) (paragraph [0002]).

Response to Arguments

38. Applicant's arguments with respect to claims 1-9 and 14-15 have been considered but are moot in view of the new ground(s) of rejection as set forth above.
39. Applicant amended claims to include a further layer of "at least one layer" in claim 1 wherein the inside edge of the first adhesive layer is located on both the inside of the first optical film and the added layer.
40. Applicant amended claims to overcome the previous 35 U.S.C. 112, second paragraph rejections of record.

41. Applicant argues that Atagi does not disclose claim 1 in light of the amendment. It is agreed that Atagi does not disclose all of claim one. Therefore, Miyazawa is used to modify Atagi as disclosed in the rejection set forth above.

42. Applicant argues that “the punching edge type of Atagi is not equivalent to the presently claimed adhesive inside edge...” Applicant simply states this argument but no evidence is provided. It is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by the applicant regarding the difference in structure between the prior art and the presently claimed invention, in particular, concerning the punching edge must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”. Clarification is requested.

43. Applicant argues that Examiner took official notice that achieving different shapes of the inside edge of the adhesive is known to one of ordinary skill in the art and requests reference to support this position. It is noted that Examiner did not cite official notice of achieving different shapes of the inside edge of the adhesive of Atagi but simply states that the claimed limitations are regarded as obvious changes in shape and are generally recognized as a design choice and as being within the level of ordinary skill in the art, absent unexpected results.

44. Applicant argues that “achieving a change in shape of the inside edge of the adhesive layer is not anticipated from the disclosure of Atagi”. It is agreed that the claimed limitations of

4, 5, 14, and 15 is not anticipated by Atagi and therefore the claims are rejected under 35 U.S.C. 103 as set forth above.

45. Applicant argues that “the disclosure of Atagi could not achieve the presently claimed shapes”. However, it is noted that “the arguments of counsel cannot take the place of evidence in the record”, *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner’s position that the arguments provided by the applicant regarding the difference in structure between the prior art and the presently claimed invention, in particular, concerning the shape of the punching edge of the adhesive of Atagi must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), “the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001”.

Conclusion

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

48. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1794

November 2, 2009

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794